

OKAWA
Serial No. 10/733,774
July 20, 2005

REMARKS

Favorable reconsideration and allowance of this application in view of the amendments above and remarks below are requested.

By way of the amendment instructions above, the limitations of claims 10-12 have been incorporated into claim 9. Claims 10-12 have thus been cancelled. Several other revisions of a clarifying nature have also been made. For example, claim 20 is new to include subject matter deleted from claim 9 and clarify that the rod-like molded article thereof may be hollow.

Therefore, claims 9 and 13-20 are presently pending in this application for which favorable reconsideration and allowance are requested.

Prior to addressing the substantive issues raised in the Official Action, applicant's assignee confirms that Duracon® M25-04 polyacetal copolymer employed in the examples of Aoshima et al exhibits property overlap with the polyoxymethylene copolymer claimed herein.

I. Response to Restriction Requirement

Applicant hereby affirms the provisional election of claims 9-19 drawn to a process for producing a stretched article. By way of the amendment instructions above, claims 1-8 directed to a patentably distinct non-elected invention have been cancelled. However, cancellation of such non-elected claims has been made without prejudice to the applicants' rights under 35 USC §121.

II. Response to Double Patenting Rejection

Claims 9-19 attracted double patenting rejections in view of U.S. patent No. 6,818,294 ("the '294 patent") and copending U.S. Application Serial No. 10/308,040

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("the '040 application"). In response, applicant's assignee is hereby enclosing herewith a Terminal Disclaimer which disclaims that portion of any patent issuing hereon which may extend beyond the expiration date of any patent issuing on the '040 application or, if not patent issues therefrom, beyond the expiration date of the '294 patent.

Additionally, the Terminal Disclaimer filed herewith also includes a provision that the patent issued hereon shall be enforceable only for and during such period that legal title thereto is the same as the legal title to the '040 application and the '294 patent.

While applicants do not concur with the Examiner's position that the improvement sought to be patented herein is merely a matter of obvious choice or design as compared to the inventions claimed in the '040 application and the '294 patent, it should be noted that, in situations such as this, the issue is not one of "obviousness", but rather one of "identity of invention." *In re Vogel*, 164 USPQ 619 (CCPA 1970), *In re Kaplan*, 229 USPQ 678 (Fed. Cir. 1986). The Court in *Vogel* set forth the test for identity of invention as whether the claims of one case could be literally infringed without literally infringing the claims of the other. It is quite apparent that one of the claims of one of the '040 application and the '294 patent and a claim of the present application could be infringed literally without infringing literally the claims of the other. Hence, there is no "identity of invention" so that the Terminal Disclaimer enclosed herewith should, in any event, resolve the asserted issues of "double patenting".

III. Response to Rejection based on Kikutani (WO 03/025268)

Claims 9-19 also attracted a rejection under 35 USC §102(a) based on Kikutani (WO 03/025268). In response, there is attached hereto a Declaration Under Rule 131 executed by the inventor of the subject application, Mr. Hidetoshi Okawa.

As noted in the Declaration, Examples 1 through 11 of the JP '793 application describe polymer compositions in accordance with the invention claimed herein that were actually made in Japan (a WTO country) prior to the December 2, 2002 filing date

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of the JP '793 application but after January 1, 1996.¹ Thus, the invention as claimed herein was made prior to the effective date of Kikutani. As such, Kikutani is unavailable as a reference against the subject application under 35 USC §102(a). Withdrawal of such rejection is therefore in order.

IV. Response to Rejections based on Aoshima (USP 4,668,761)

Claims 9-12, 18 and 19 attracted a rejection under 35 USC §102(b) as allegedly anticipated by or, in the alternative, under 35 USC §103(a) as allegedly obvious over Aoshima et al (USP 4,668,761). In addition, Aoshima was applied to reject separately claims 13-17 under 35 USC §103(a). Applicant submits, however, that Aoshima is inappropriate as a reference against the amended claims herein.

In this regard, applicant notes that the presently claimed invention is patentably distinct from Aoshima in that it requires stretching the melt-extruded product at a normal (i.e., atmospheric) pressure and then heat-fixing the stretched product at 120⁰C or higher. Aoshima does not disclose such stretching and heat-fixing steps as defined in claim 9 and thus cannot anticipate or render obvious such claim.

Withdrawal of the rejections advanced under 35 USC §§102(b) and 103(a) is therefore in order.

¹ It is noted that Rule 131 limits evidence of prior invention in a WTO country other than a NAFTA country (e.g., Japan) to those made subsequent to January 1, 1996.

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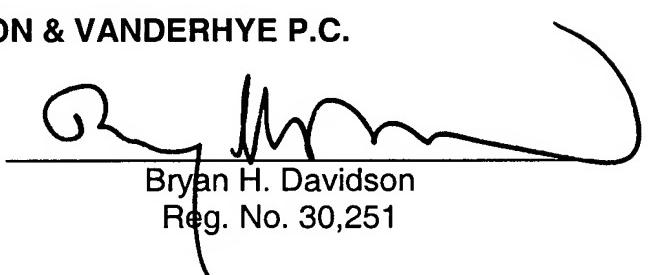
V. Conclusions

Every effort has been made to advance prosecution of this application to allowance. Therefore, in view of the amendments and remarks above, applicant suggests that this application is in condition for allowance and official notice to that effect is solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:


Bryan H. Davidson
Reg. No. 30,251

BHD:lmv
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100